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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,974	10/09/2003	Toshio Yamamoto	VTN629NP	7789
27777	7590	06/15/2006		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER PORTER, RACHEL L	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/681,974

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

Rachel L. Porter

**Art Unit**

3626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed on 10/18/05. Claims 1-17 have been cancelled. Claims 18-32 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19-32 currently recite that they are dependent from several claims which are no longer pending in the application. For the purpose of applying art, the examiner will interpret the claims as being directly dependent from claim 18 and apply art accordingly.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/05 has been entered.

***Response to Arguments***

5. Applicant's arguments with respect to claims 18-32 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-19,23,26-28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over 1800CONTACTS Website printout packet (archived as of March 3, 2000) in view of Pauly et al (USPN 4,958,280).

[claim 18] 1800CONTACTS discloses an online method of supplying contact lenses to a patient, the method comprising the steps of:

- receiving into an online system an indication of an authorized reseller, (page 1— world's largest contact lens store)

- receiving into the online system from the authorized reseller an indication of a price to charge a consumer for a specific quantity of a particular contact lens; (pages 6-7)
- receiving into the online system an indication of a prescription for the patient, associated with the consumer, to receive the particular contact lens and comprises a lens brand, lens power, a lens diameter and (page 4—What does my prescription contain? response) a prescription date;
- receiving into the online system an indication of an order from the consumer for the patient to receive a specific quantity of the particular contact lens (page 3—“Internet ordering”)
- charging the consumer for the order based upon the price to charge for a specific quantity of a particular contact lens; and (Page 3, internet ordering and F.A.Q. )
- generating delivery instructs to ship the particular contact lenses directly to the patient. (page 4—How soon can I expect to receive my order?)

1800Contacts discloses an online method of selling contacts through an authorized retailer, but does not expressly disclose the use of a rule to calculate a suggested quantity for the consumer. 1800 contacts also does not expressly disclose an oculist associated with the reseller.

Pauly discloses a system and method, which includes and oculist associated with the contact sales operations, who authorizes the prescriptions (col. 4, lines 39-50) and

wherein the date of the prescription order is noted. (col. 6, lines 6-33) Pauly further discloses a method further comprising :

- receiving into the online system an indication of a rule to be applied for calculations of a suggested quantity of contact lenses; (col. 6, lines 18-38; col. 7, lines 9-31)
- automatically calculating a suggested quantity of contact lenses based upon the lens brand, the prescription date and the rule to be applied to calculations for a suggested quantity of contact lenses; and (col. 6, lines 18-38, col. 7, lines 33-36)
- ascertaining that the specific quantity ordered does not exceed the automatically calculated quantity of contact lenses; (col. 6, lines 18-38; col. 6, lines 51-56 )

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of 1800CONTACTS with the teaching of Pauly to have an oculist verify the prescriptions and to provide rules to suggest and check ordered quantities. As suggested by Pauly, one would have motivated to include these features to avoid unnecessary and overly frequent by patient to obtain eye care products, while allowing the eye care professional to maintain some control in the dispensing process. (col. 1, lines 60-67)

[claim 19] 1800Contacts discloses a method of claim 21, additionally comprises the steps of:

- receiving into the online system an indication of a default prescription duration associated with the authorized reseller; (page 2—default prescription kept on file)

- presenting the default prescription period to the authorized reseller for the prescription and receiving an indication of whether the authorized reseller accepts or modifies the default prescription period. (page 8—order tracking will indicate delays in sending prescription(s))

[claim 23] 1800Contacts and Pauly disclose the system/method of claim 18 as explained in the rejection of claim 18. Pauly further discloses a method further comprising the steps of: receiving into the online system an indication of the identification of a patient; (col. 6, lines 12-17) receiving into the online system an indication of the identification of an authorized resell; (col. 6, lines 18-38; col. 12; lines 51-59) and generating a notification to the authorized reseller that the patient is included on a list comprising patients awaiting contact lens prescription fulfillment. (col. 10, lines 9-23). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of 1800Contacts with the teaching of Pauly. As suggested by Pauly, one would have motivated to include these features to avoid unnecessary and overly frequent by patient to obtain eye care products, while maintaining some control in the dispensing process. (col. 1, lines 60-67)

[claims 26-28] 1800Contacts and Pauly in combination disclose the method/system of claim 18 as explained in the rejection of claim 18. 1800Contact further discloses payment through a third party clearing house (pages 1-3,6—They sell manufacturers merchandise to the patient and therefore are a third party). However, 1800Contacts

does not expressly disclose calculating the wear schedule and storing the patient records and presenting reports or prescriptions received by the patient. Pauly discloses calculating a schedule indicating when ordered contact lenses will be worn and when they will be discarded. (col. 5, lines 19-40). Pauly further discloses storing in the online system a record of all prescriptions received that are associated with a specific consumer; and presenting a report indicating two or more of the prescriptions received that are associated with the specific consumer. (col. 6, lines 7-33; col. 14, lines 51-69)

[claim 32] 1800 discloses a system wherein the consumer and the patient are the same person. (page 3)

8. Claims 20-22,24-25, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over 1800CONTACTS Website printout packet (archived as of March 3, 2000) and Pauly et al (USPN 4,958,280) as applied to claim 18, and in further view of Stasny (USPAP 2003/0074234)

[claims 20-21] 1800Contacts and Pauly disclose the method of claim 18. Furthermore, Pauly discloses calculating a quantity of contacts to order as explained in the rejection of claim 19. Furthermore, Pauly discloses that the wear schedule must be considered when placing orders. (col. 5, lines 19-40) However, 1800 contacts and Pauly in combination do not determining the time remaining until a prescription expires, and the



maximum quantity to be ordered based upon prescription expiration. Stasny discloses a system/method that determines when a prescription expires and adjusts refilling schedule based upon the prescription regimen. (par. 52,74-75) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/ system of 1800Contacts and Pauly with the teaching of Stasny. As suggested by Stasny, one would have been motivated to include these features to allow customers to have a more active role their healthcare and to encourage patient treatment compliance by tracking prescription usage. (par. 16-17,19)

[claim 22] 1800Contacts and Pauly disclose the method of claim 18, as explained in the rejection of claim 18. 1800Contacts further discloses that special pricing is available for orders (e.g. free shipping, lenses are cheaper than when purchased from doctor: page 3). However, 1800Contacts and Pauly do not expressly disclose receiving an order date of the order from the consumer, receiving into the online system an indication of special pricing available for one or more products and an indication of a time period for which the discount will apply, determining if the discount applies and applying the discount if applicable.

Stasny discloses a system/method which includes providing discounts and special pricing offers to particular customers at particular times and for particular orders and applying/ charging the discounted rate if the particular prescription has been ordered. (par. 53) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of 1800Contacts and Pauly

in combination with the teaching of Stasny. As suggested by Stasny, one would have been motivated to include these features to encourage consumer participation in decisions in healthcare options and to allow them to financially explore additional treatment options (par. 15).

[claims 24-25] 1800Contacts discloses a system/ method additionally comprising: transmitting to the consumer an indication of the suggested quantity of contact lenses and the variables used to calculate the suggested quantity. (page 4-5: System provides a webpage to inform the consumer what his/her prescription includes) However, 1800Contacts and Pauly in combination do not expressly disclose receiving into the online system an indication from the consumer that a suggested quantity of a prescription has been ordered or generating an automated notification to the consumer indicating that a prescription for contact lenses for the patient has been entered. Stasny teaches a method and system which receives into the online system an indication from the consumer that he/she has ordered a suggested quantity of a prescription (Figures 13-14). Stasny further discloses generating an automated message to the consumer that an order has been entered (Figure 13, par. 88-89). At the time of the Applicant's invention, it would have been obvious to modify the method/system of 1800Contacts and Pauly in combination with the teaching of Stasny.

As suggested by Stasny, one would have been motivated to include these features to allow customers to have a more active role their healthcare and to encourage patient treatment compliance by tracking prescription usage. (par. 16-17,19)

[claims 29-31] 1800Contacts and Pauly disclose the method of claim 18. Furthermore, Pauly discloses calculating a quantity of contacts to order as explained in the rejection of claim 19. Furthermore, Pauly discloses that the wear schedule must be considered when placing orders. (col. 5, lines 19-40) However, 1800 contacts and Pauly in combination do not determining the time remaining until a prescription expires, and the maximum quantity to be ordered based upon prescription expiration. Stasny discloses a system/method that determines when a prescription expires and adjusts refilling schedule based upon the prescription regimen. (par. 52,74-75) Stasny further discloses that the user may edit an order (par. 74-75, Figure 9) and that a patient may be emailed regarding refill information (par. 52) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of 1800Contacts and Pauly with the teaching of Stasny. As suggested by Stasny, one would have been motivated to include these features to allow customers to have a more active role their healthcare and to encourage patient treatment compliance by tracking prescription usage. (par. 16-17,19)

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER